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PAULEY PETERSEN & ERICKSON

SUITE 365

2800 WEST HIGGINS ROAD

HOFFMAN ESTATES, ILLINOIS 60169

TELEPHONE (847) 490-1400

FACSIMILE (847) 490-1403

PATENT, TRADEMARK, COPYRIGHT
AND RELATED MATTERSDOUGLAS H. PAULEY
MAXWELL J. PETERSEN
KEVIN D. ERICKSON
NICK C. KOTTIS
MELANIE I. RAUCH
MARGARET M. CROSBY
MARK D. SWANSON
ANNA SWIETEK
JOHN P. POLIAKOF COUNSEL
THOMAS W. SPECKMAN

FACSIMILE

To: U.S. Patent and Trademark Office

Fax No.: 1-571-273-8300

From: Maxwell J. Petersen

Re: REQUEST FOR RECONSIDERATION

Applicants: Baratian et al.

Serial No.: 10/750,535

Filing Date: 31 December 2003

Title: RETRACTABLE NONWOVEN LAYERS
HAVING MINIMAL APPLICATION OF
COALESCED ELASTOMERS

Date: 05 July 2007

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Attorney Docket No.: 19392

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Applicants: Stephen Avedis BARATIAN
Phillip A. SCHORR
Arthur Edward GARAVAGLIA
Susan Carol SUDBECK
Dan K. SCHIFFER
Mark Bruce MAJORS
Kimberly Nicole SANDERS
David Lewis MYERS
Glen Thomas MILDENHALL
Oomman Painummoottil THOMAS

Group No.: 1771 JUL 05 2007

Serial No.: 10/750,535

Filing Date: 31 December 2003

Examiner: Jenna L. Davis

Title: RETRACTABLE NONWOVEN LAYERS
HAVING MINIMAL APPLICATION OF
COALESCED ELASTOMERS

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REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Office Action dated 04 May 2007, Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 1-12, 14-35, 40, 43, 46, 54 and 57-59 under 35 U.S.C. §103(a), as obvious over U.S. Publication 2003/0088228 ("Desai") in view of U.S. Publication 2003/0111166 ("Uitenbroek"), with or without U.S. Patent 6,057,024 ("Mleziva").

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Maxwell J Petersen

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7-5-07

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a) **"Coalesced" And "Charged" Are Structural Limitations And Not Product-By-Process Limitations.**

Applicants' Claims 1 and 33 recite "the coalesced elastomeric stripes comprising charged electrospun microfibers or droplets." The Examiner asserts that this entire clause is a product-by-process limitation. Applicants respectfully disagree as this limitation is structural, in that it describes the manufacture (retractive composite web).

Regarding product-by-process claims, MPEP § 2113 states:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." (Emphasis added).

In this case, Applicants' "charged" electrospun microfibers or droplets result in a structurally different retractive composite web having unobvious and unexpected results as shown in Table 4. The modulus of elasticity is improved by 40% to 100% versus the control samples.

Words used as descriptive adjectives having sufficient definitions of physical characteristics are interpreted as structural limitations. Use of a word as a past participle or an adjective should be taken from the context in which is used (specification). For all the reasons stated in the previous response, "charged" is used as adjective.

The main case for distinguishing product-by-process limitations and structural limitations is *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) which held on page 279 that:

However, it seem[s] to us that the recitation of the particles as "interbonded one to another by interfusion between the surfaces of the perlite particles" is as capable of being construed as a structural limitation as "intermixed," "ground in place," "press fitted," "etched," and "welded," all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations. (Emphasis added).

Similarly, "coalesced" and "charged" may be associated with processing steps but provide an objective characteristic observable by inspection of the manufacture (retractive

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composite web). These limitations are further evidenced by differences versus the control samples in hysteresis, first cycle immediate set, second cycle immediate set, intake time, and elastic modulus as shown in Figs. 6-10.

Several more recent cases further support that Applicants' claimed "coalesced" and "charged" words are structural limitations and not product-by-process limitations. *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA, 1971) found "highly fluorinated" to not be a product-by-process limitation. The Federal Circuit found claims reciting "chemically engraved" were best characterized as **pure product claims** since they describe the structure rather than the process to obtain it. *Hazani v. U.S. Int'l Trade Comm'n*, 126 F.3d 1473, 44 USPQ2d 1358 (Fed. Cir., 1997).

Union Carbide Chemical & Plastic Tech v. Shell Oil, 308 F.3d 1167, 64 USPQ2d 1545 (Fed. Cir., 2002) found catalyst "characterizable by an efficiency equation" not a product-by-process claim. It is clear from the cases above that the courts interpret many limitations to be structural limitations rather than product-by-process limitations. Put another way, since "characterizable by an efficient equation" which requires applying a mapping formula is a structural limitation, then descriptive adjectives are structural limitations also.

In this case, Applicants' "coalesced" structural limitation refers to microfibers or droplets resulting in a more precisely and tightly applied elastomeric stripe having regions of desirably improved retractive force in the composite web. Similarly, Applicants' "charged" structural limitation refers to a particular state that results in a more precisely and tightly applied elastomeric stripe having regions of desirably improved retractive force in the composite web. Both "coalesced" and "charged" are descriptive adjectives of the physical state of the manufacture (composite web).

For all the above reasons "coalesced" and "charged" are structural limitations and should be given proper deference versus materials that are not charged or coalesced.

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b) "Coalesced" And "Charged" Microfibers Or Droplets Are Unobvious And Have Unexpected Results.

Even if "coalesced" and "charged" are product-by-process limitations, there is sufficient evidence in the Specification to patentably distinguish Applicants' composite web as unobvious over conventional composite webs. In no way should this argument be construed as an admission that "coalesced" and "charged" are product-by-process limitations.

Applicants agree with the Examiner regarding product-by-process claims where upon finding a product of the same or similar to the claimed invention, the burden shifts to the Applicants to show evidence establishing an unobvious difference. (*See, In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir., 1983).

Applicants again refer to the Tables and the Figures in the Specification, particularly Table 4 showing "charged" materials with improved modulus of elasticity by 40% to 100% versus the control samples. Increases of 40% to 100% represent measurable nonobvious and unexpected results. Applicants, also show nonobviousness of the improved retractive composite laminate by the differences versus the control samples in hysteresis, first cycle immediate set, second cycle immediate set, intake time, and elastic modulus as shown in Figs. 6-10. Therefore, the showing of a different and unobvious product according to *in re Marosi* is accordingly satisfied.

Furthermore, in *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989), the Board states that the **dispositive issue** is whether the claimed factor exhibits **any unexpected properties** compared with the factor disclosed by the prior art. The Board further stated that the applicant should have made some comparison between the two factors to establish unexpected properties. In this case, one skilled in the art would not expect that "coalesced" and "charged" microfibers or droplets would make a composite web more retractive. A sufficient comparison is readily found in Figs. 6-10 and in Tables 1-4 of the specification. Typical "charged" materials include paint with improved adhesion or coating capabilities. One skilled in the art would not expect that "charged" microfibers of droplets would have improved retractive forces as evidenced by elasticity modulus,

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discussed above. Therefore, "charged" microfibers or droplets in a retractive composite web have unexpected results.

For all the above reasons "coalesced" and "charged" microfibers or droplets are unobvious and have unexpected results.

c) Claim Rejection Based on Desai In View Of Uitenbroek.

The rejection of Claims 1-12, 14-35, 43, 46, 54 and 57-59 under 35 U.S.C. §103(a) as obvious over U.S. Publication 2003/0088228 ("Desai") in view of U.S. Patent 6,827,806 ("Uitenbroek") is respectfully traversed. The Examiner also cited U.S. Publication 2003/0111166, which has the same disclosure as U.S. Patent 6,827,806.

The Examiner has repeated the previous rejection based on assertions that that "charged" is a product-by-process limitation. The Examiner has stated that no degree of "charge" is claimed. Applicants' respectfully disagree. The cases above finding adjectives to be structural limitations do not require a quantity of the structural limitation to be patentable. Put another way, the Federal Circuit did not require a 90% confidence interval for the "characterizable by an efficiency equation" limitation in *Union Carbide Chemical & Plastic Tech v. Shell Oil*. Requiring a degree of "charge" is unnecessary and improper.

Regarding the Examiners' assertion that all materials are charged, Applicants respectfully disagree. Not all materials are "charged" and can form a composite web with improved retractive force. If this were true there would be no difference in the data points on Figs. 6-10. This respectfully is not accurate. There are clear differences between the "charged" materials and the "control" for the measured characteristics.

The Examiner has made wholesale sweeping rejections of the dependent claims by stating these are obvious to one skilled in the art, inherent in the material or are result effective variables. Applicants again respectfully disagree. Shifting the burden of proof on the Applicants is unnecessary if the Examiner properly reads the claims in light of the specification. These characteristics are different than the conventional composite webs

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since they are made from "charged" microfibers or droplets as evidenced in Figs. 6-10, discussed above.

Furthermore the characteristics of the dependent claims further limit "charged" microfibers or droplets. These recited values distinguish Applicants' invention over conventional composites.

The *prima facie* requirements for obviousness are: 1) a motivation to combine the references, 2) an expectation of success, and 3) disclosure of all limitations. (See, MPEP § 2143).

In this case, both Desai and Uitenbroek are silent with respect to "coalesced", "charged" and "electrospun". The Examiner appears to cite Uitenbroek only for allegedly disclosing droplets. (See, page 6-7 of the 13 October 2006 Office Action).

Desai, the primary obviousness reference, discloses a variable stretch composite. Desai does not teach or suggest Applicants' "charged" microfibers or droplets having unobvious results. Put another way, since Desai seeks to make a variable stretch composite, it would disclose structures to improve stretch. Since it does not teach or suggest "charged" microfibers or droplets, Desai does not provide a motivation to modify or an expectation of success to modify the composite of Desai to arrive at Applicants' composite web having "charged" microfibers or droplets. Desai does not disclose all the limitations of Applicants' claims.

Uitenbroek does not close the gaps of Desai to arrive at Applicants' retractive composite web having "charged" microfibers or droplets with unobvious results. Since Uitenbroek does not teach or suggest "charged" microfibers or droplets, Uitenbroek does not provide a motivation or an expectation of success to modify the composite of Desai to arrive at Applicants' composite web having "charged" microfibers or droplets. Uitenbroek does not disclose all the limitations of Applicants' claims.

For all the reasons discussed above, Desai and Uitenbroek, taken in proper combination, do not teach or suggest Applicants' claimed invention. The Examiner has not cited references having any of the three *prima facie* requirements for a proper obviousness rejection. Accordingly, this rejection should be withdrawn.

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d) Claim Rejection Based on Desai In View Of Uitenbroek And Mleziva.

The rejection of Claim 40 under 35 U.S.C. §103(a) as obvious over Desai in view of Uitenbroek and U.S. Patent 6,057,024 ("Mleziva") is respectfully traversed. Claim 40 depends from Claim 1 and is patentable for at least the same reasons, explained above.

Mleziva is cited as disclosing elastomeric material in the form of microfibers according to page 8 of the 13 October Office Action. Mleziva does not close the gaps of Desai and Uitenbroek to arrive at Applicants' claimed invention.

Mleziva does not teach or suggest coalesced elastomeric stripes comprising charged electrospun microfibres or droplets.

For all the reasons discussed above, Desai, Uitenbroek and Mleziva, taken in proper combination, do not teach or suggest Applicants' claimed invention. The Examiner has not cited references having any of the three *prima facie* requirements for a proper obviousness rejection. Accordingly, this rejection should be withdrawn.

e) Conclusion.

As explained above, the rejection of every claim hinges on the Examiner's assumption that the phrase "charged electrospun microfibers or droplets" is only a product-by-process limitation and not a structural limitation. To the contrary, the word "charged" (when interpreted according to the specification) indicates that the microfibers or droplets are in a charged state, which is a structural (product) limitation. A person of ordinary skill in the art would understand (based on the specification) that this is the intended meaning. No reference discloses the product-by-process limitation. Even if "charged" is a product-by-process limitation, the "charged" microfibers or droplets have unexpected and unobvious results.

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Applicants believe that the claims are in condition for allowance. If the Examiner detects any unresolved issues, then Applicants' attorney respectfully requests a telephone call from the Examiner, and a telephone interview.

Respectfully submitted,



Maxwell J. Petersen
Registration No. 32,772

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60169
TEL (847) 490-1400
FAX (847) 490-1403

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